

REMARKS

In the Office Action dated August 13, 2008, the Examiner withdrew claims 61-69 from further consideration pursuant to 37 CFR 1.142(b), as allegedly being drawn to a nonelected invention; provisionally rejected claims 1-60 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/552,631; advised that should claims 24-43 be found allowable, claims 44-60 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof; objected to the specification based on informalities; objected to claims 1, 35, and 38 based on informalities; rejected claims 1-22, 27, and 47 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 1, 9-12, 14, 15, 23, 24, 32-35, 37, 44, and 52-56 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,637,214 to Kahana ("Kahana"); rejected claims 1, 9-13, 23, and 32-36 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,932,117 to O'Brien ("O'Brien"); rejected claims 1, 5-7, 10, 11, 13, 18-21, 23, 28-30, 33, 34, 36, and 39-42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,976,370 to Medworth ("Medworth"); rejected claims 1, 9-12, 14, 15, 23, 24, 32-35, 37, 44, and 52-57 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,766,907 to Barlow ("Barlow"); rejected claims 22, 43, and 60 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Kahana; rejected claims 2-8, 25-31, and 45-51 under 35 U.S.C. § 103(a) as being unpatentable over Kahana; rejected claims 17, 38, and 59 under 35 U.S.C. § 103(a) as unpatentable over Kahana in view of U.S. Patent No. 4,421,646 to Correge et al. ("Correge"), U.S. Patent No. 3,730,348 to Weis et al. ("Weis"), and U.S. Patent No. 3,317,044 to Marks

(“Marks”); rejected claims 18-21 and 39-41 under 35 U.S.C. § 103(a) as unpatentable over Kahana in view of Medworth; and rejected claims 16 and 58 under 35 U.S.C. § 103(a) as unpatentable over Barlow in view of U.S. Patent No. 5,545,318 to Richmond (“Richmond”).

By this Reply, Applicant has canceled claims 1-22, 25, and 45, has amended claims 23, 35, 38, 39, 44, 46-53, and 59, and has added new claims 70 and 71. Claims 23-71 are currently pending in this application (claims 61-69 having been previously withdrawn by the Examiner). No new matter is added by this Reply.

As noted above, the Examiner rejected claims 1-60 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/552,631. Applicant respectfully disagrees with the assertions made by the Examiner in formulating the obviousness-type double patenting rejections set forth at pages 2-3 of the Office Action. In order to expedite prosecution of this application, however, Applicant submits herewith a Terminal Disclaimer to obviate the double patenting rejections. The filing of the Terminal Disclaimer in no way manifests an admission by Applicant as to the propriety of the double patenting rejections. See M.P.E.P. § 804.02 citing Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Applicant reserves the right to traverse the double patenting rejections at a later date. Applicant respectfully requests the withdrawal of the double-patenting rejection in view of the Terminal Disclaimer attached hereto.

The Examiner also advised that should claims 24-43 be found allowable, claims 44-60 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

Applicant disagrees with the Examiner's characterization of these claims, however, in order to expedite prosecution of this application, Applicant has amended claim 44, thereby rendering any potential duplication objection by the Examiner moot.

The Examiner also objected to the specification based on informalities. Applicant's amendment of the specification by this Reply renders the Examiner's objection moot. Thus, Applicant respectfully asks the Examiner to withdraw this objection.

The Examiner further objected to claims 1, 35, and 38 based on informalities. Applicant's amendment of claims 35 and 38 and the cancellation of claim 1 by this Reply renders the Examiner's objection moot. Thus, Applicant respectfully asks the Examiner to withdraw these objections.

Applicant respectfully traverses the Examiner's rejection of claims 1-22, 27, and 47 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant's cancellation of claims 1-22 renders the rejection with respect to those claims moot. Moreover, Applicant's amendment of claims 27 and 47 and addition of new claims 70 and 71 obviates the Examiner's rejection with respect to those claims. Accordingly, Applicant asks the Examiner to withdraw these rejections.

Rejections Under 35 U.S.C. § 102

Applicant respectfully traverses the Examiner's rejection of claims 1, 9-12, 14, 15, 23, 24, 32-35, 37, 44, and 52-56 under 35 U.S.C. § 102(b) as being anticipated by Kahana. First, Applicant submits that the rejection of claims 1, 9-12, 14, and 15 is rendered moot by the cancellation of these claims. Second, Applicant submits that Kahana does not disclose each and every element of amended claims 23 and 44, for

example. Claim 23 has been amended to include the limitation of previously-filed (now canceled) claim 25 and claim 44 has been amended to include the limitation of previously-filed (now canceled) claim 45. Applicant submits that Kahana does not disclose a “filter configured to permit passage of the liquid through the filter, but to prevent passage of the particulate material through the filter . . . wherein the filter includes . . . a second extension being substantially perpendicular to the filter direction (x) . . . and also significantly shorter than the length of the slit-shaped opening in the filter direction (x),” as recited in amended claim 23, for example. The Examiner concedes as much by virtue of the fact that the Examiner did not reject previously-filed dependent claim 25 (which has been incorporated into amended claim 23) under § 102 as anticipated by Kahana. Amended claim 44 contains a similar limitation as amended claim 23, relating to the length of the second extension in the filter direction. This limitation has been incorporated into amended claim 44 from previously-filed dependent claim 45, which the Examiner also did not reject under § 102 as anticipated by Kahana. Accordingly, for at least the reasons discussed above, amended independent claims 23 and 44 are not anticipated by Kahana and are allowable. Thus, dependent claims 24, 32-35, 37, and 52-56 are not anticipated by Kahana and are allowable at least due to their dependence from allowable amended independent claims 23 and 44. Applicants request that the Examiner withdraw these rejections.

Applicant respectfully traverses the Examiner’s rejection of claims 1, 9-13, 23, and 32-36 under 35 U.S.C. § 102(b) as being anticipated by O’Brien. First, Applicant submits that the rejection of claims 1 and 9-13 is rendered moot by the cancellation of these claims. Second, Applicant submits that O’Brien does not disclose each and every

element of amended independent claim 23. Applicant submits that O'Brien does not disclose a “filter configured to permit passage of the liquid through the filter, but to prevent passage of the particulate material through the filter . . . wherein the filter includes . . . a second extension being substantially perpendicular to the filter direction (x) . . . and also significantly shorter than the length of the slit-shaped opening in the filter direction (x),” as recited in amended claim 23, for example. As discussed above with respect to the § 102 rejection based on Kahana, the Examiner concedes that O'Brien does not disclose this limitation of amended claim 23 by virtue of his failure to reject previously-filed dependent claim 25 under § 102 as anticipated by O'Brien. Accordingly, for at least these reasons, amended claim 23 is not anticipated by O'Brien and is allowable. Thus, dependent claims 32-36 are allowable at least due to their dependence from allowable independent claim 23.

Applicant respectfully traverses the Examiner's rejection of claims 1, 5-7, 10, 11, 13, 18-21, 23, 28-30, 33, 34, 36, and 39-42 under 35 U.S.C. § 102(b) as being anticipated by Medworth. First, Applicant submits that the rejection of claims 1, 5-7, 10, 11, 13, and 18-21 is rendered moot by the cancellation of these claims. Second, Applicant submits that Medworth does not disclose each and every element of amended independent claim 23. Applicant submits that Medworth does not disclose a “filter configured to permit passage of the liquid through the filter, but to prevent passage of the particulate material through the filter . . . wherein the filter includes . . . a second extension being substantially perpendicular to the filter direction (x) . . . and also significantly shorter than the length of the slit-shaped opening in the filter direction (x),” as recited in amended claim 23, for example. As discussed above with respect to the

§ 102 rejection based on Kahana, the Examiner concedes that Medworth does not disclose this limitation of amended claim 23 by virtue of his failure to reject previously-filed dependent claim 25 under § 102 as anticipated by Medworth. Accordingly, for at least these reasons, amended claim 23 is not anticipated by Medworth and is allowable. Thus, dependent claims 8-30, 33, 34, 36, and 39-42 are allowable at least due to their dependence from allowable independent claim 23.

Applicant respectfully traverses the Examiner's rejection of claims 1, 9-12, 14, 15, 23, 24, 32-35, 37, 44, and 52-57 under 35 U.S.C. § 102(e) as being anticipated by Barlow. First, Applicant submits that the rejection of claims 1, 9-12, 14, and 15 is rendered moot by the cancellation of these claims. Second, Applicant submits that Barlow does not disclose each and every element of amended independent claims 23 and 44. Applicant submits that Barlow does not disclose a "filter configured to permit passage of the liquid through the filter, but to prevent passage of the particulate material through the filter . . . wherein the filter includes . . . a second extension being substantially perpendicular to the filter direction (x) . . . and also significantly shorter than the length of the slit-shaped opening in the filter direction (x)," as recited in amended claim 23, for example. As discussed above with respect to the § 102 rejection based on Kahana, the Examiner concedes that Barlow does not disclose this limitation of amended claim 23 by virtue of his failure to reject previously-filed dependent claim 25 under § 102 as anticipated by Barlow. As discussed above, amended claim 44 contains a new limitation similar to that of amended claim 23, which was incorporated from previously-filed dependent claim 45. The Examiner similarly did not reject previously-filed dependent claim 45 under § 102 as anticipated by Barlow. Accordingly, for at least

these reasons, amended independent claims 23 and 44 are not anticipated by Barlow and are allowable. Thus, dependent claims 32-35, 37, and 52-57 are allowable at least due to their dependence from allowable independent claims 23 and 44.

Applicant respectfully traverses the Examiner's rejection of claims 22, 43, and 60 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Kahana. First, Applicant submits that the rejection of claim 22 is rendered moot by the cancellation of claim 22. Second, as discussed above, Applicant submits that Kahana does not disclose each and every element of amended independent claims 23 and 44, from which claims 43 and 60 respectively depend. Thus, for at least the reasons discussed above with respect to the other § 102(b) rejections based on Kahana, dependent claims 43 and 60 are allowable at least due to their dependence from allowable independent claims 23 and 44. The obviousness rejections under § 103(a) of pending claims based on Kahana and other cited references are addressed below.

Rejections Under 35 U.S.C. § 103

Applicant respectfully traverses the Examiner's rejection of claims 2-8, 25-31, and 45-51 under 35 U.S.C. § 103(a) as being unpatentable over Kahana. First, Applicant submits that the rejection of claims 2-8 is rendered moot by the cancellation of these claims. Claims 25 and 45 have been canceled, however, the limitations of claims 25 and 45 have been incorporated into amended independent claims 23 and 44, respectively. Thus, for the purpose of responding to this rejection, Applicant will address amended independent claims 23 and 44. As a result, Applicant submits that Kahana does not disclose each and every limitation of amended claims 23 and 44.

Kahana dose not disclose a “filter configured to permit passage of the liquid through the filter, but to prevent passage of the particulate material through the filter . . . wherein the filter includes . . . a second extension being substantially perpendicular to the filter direction (x) . . . and also significantly shorter than the length of the slit-shaped opening in the filter direction (x),” as recited in amended claim 23, for example. The Examiner concedes as much, stating that Kahana “does not teach the length in the filter direction being significantly greater than the second extension.” (Office Action at 14.) The Examiner contends, however, that the “only difference between the prior art and the claimed invention is a recitation of relative dimension. [W]here the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *Gardner v. TEC Systems, Inc.*, 220 USPQ 777 (1984).” (Office Action at 14-15.)

Applicant disagrees with the Examiner’s characterization of both Kahana and the claimed invention and submits that the Examiner has misapplied the Federal Circuit’s holding provided in *Gardner v TEC Systems*. In particular, the Examiner has ignored the Court’s use of two key phrases: (1) where the only difference between the prior art and the claims was a recitation of relative dimension; and (2) a device having the claimed relative dimension would not perform differently than the prior art device. (Emphasis Added.) Applicant contends that the alleged recitation of relative dimension is not the only difference between the invention recited in amended claim 23 and the prior art invention disclosed in Kahana. Moreover, the invention recited in amended

claim 23 perform significantly different from the prior art device disclosed in Kahana. In particular, the filter assembly disclosed in Kahana comprises a filter bag 38 provided in a filter housing 34 having elongated slit-shaped openings 64 and 72. These openings are significantly larger than the filter particles because the filter particles are kept in place by filter bag 38, which has small pores. Thus, the slit-shaped openings 64 and 72 in the filter housing 34 of Kahana do not prevent particles from passing through, because the filter bag 38 functions to prevent such passage. Instead, the slit-shaped openings 64 and 72 function to permit the passage of fluid that has been filtered by the filter bag 38.

To the contrary, the slit-shaped openings of the filter of the claimed invention, as recited in amended claim 23, for example, contribute to the reliability of the filtering function and the ability of the filter to prevent any particles from passing therethrough. In particular, the claimed feature of the second extension (or width of the slit-shaped opening) being “significantly shorter than the length of the slit-shaped opening in the filter direction (x),” as recited in amended claim 23, defines a thin slit-shaped opening configured to prevent particles from passing through the filter. Accordingly, the slit-shaped openings disclosed in Kahana function in a different manner than that of the claimed invention. Moreover, one of skill in the art with knowledge of Kahana would not be able to achieve a filter having the slit-shaped openings with the features recited in amended claim 23 that prevents particles from passing through the filter. Thus, for at least the reasons discussed above, amended claim 23 is not obvious over Kahana and is allowable. Amended claim 44 contains a limitation similar to the feature that has rendered amend claim 23 allowable over Kahana. According, amended claim 44 is also

allowable over Kahana. Thus, claims 26-31 and 46-51 are allowable at least due to their dependence from allowable independent claims 23 and 44.

Applicant respectfully traverses the Examiner's rejection of claims 17, 38, and 59 under 35 U.S.C. § 103(a) as unpatentable over Kahana in view of Correge, Weis, and Marks. First, Applicant submits that the rejection of claim 17 is rendered moot by the cancellation of claim 17. With respect to claims 38 and 59, which depend indirectly from amended independent claims 23 and 44, respectively, Applicant reiterates that Kahana does not disclose a "filter configured to permit passage of the liquid through the filter, but to prevent passage of the particulate material through the filter . . . wherein the filter includes . . . a second extension being substantially perpendicular to the filter direction (x) . . . and also significantly shorter than the length of the slit-shaped opening in the filter direction (x)," as recited in amended claim 23, for example. As discussed above, amended claim 44 contains a similar limitation. The Examiner contends that Correge, Weis, and Marks disclose changing the shape of slit-shaped openings. (Office Action at 16.) Correge, Weis, and Marks do not, however, cure the above-mentioned deficiencies of Kahana. Accordingly, the cited references do not disclose each and every limitation of amended independent claims 23 and 44. Therefore, these claims are allowable over the cited references. Thus, claims 38 and 59 are allowable at least due to their dependence from allowable independent claims 23 and 44.

Applicant respectfully traverses the Examiner's rejection of claims 18-21 and 39-41 under 35 U.S.C. § 103(a) as unpatentable over Kahana in view of Medworth. Applicant submits that the rejection of claims 18-21 is rendered moot by the cancellation of these claims. With respect to claims 39 and 41, which depend indirectly from

amended independent claim 23, Applicant reiterates that Kahana does not disclose a “filter configured to permit passage of the liquid through the filter, but to prevent passage of the particulate material through the filter . . . wherein the filter includes . . . a second extension being substantially perpendicular to the filter direction (x) . . . and also significantly shorter than the length of the slit-shaped opening in the filter direction (x),” as recited in amended claim 23. The Examiner contends that Medworth discloses “a filter having a first disc (24) and a second disc (26) which are arranged substantially parallel and separated from each other by an interspace that forms a slit shaped opening.” (Office Action at 16.) Medworth does not, however, cure the above-mentioned deficiencies of Kahana. Accordingly, the cited references do not disclose each and every limitation of amended independent claim 23. Therefore, claim 23 is allowable over the cited references. Thus, claims 39 and 41 are allowable at least due to their dependence from allowable independent claim 23.

Applicant respectfully traverses the Examiner’s rejection of claims 16 and 58 under 35 U.S.C. § 103(a) as unpatentable over Barlow in view of Richmond. Applicant submits that the rejection of claim 16 is rendered moot by the cancellation of claim 16. With respect to dependent claim 58, which depends indirectly from amended independent claim 44, Applicant submits that Barlow does not disclose a “filter configured to permit passage of the liquid through the filter, but to prevent passage of the particulate material through the filter . . . wherein the filter includes . . . a second extension being substantially perpendicular to the filter direction (x) . . . and also significantly shorter than the length of the slit-shaped opening in the filter direction (x),” as recited in amended claim 44. The Examiner contends that Richmond “teaches a

peripheral support (66) for a filter that includes a plurality of ridges (88) projecting from the peripheral surface and abuts an inner wall of a cartridge, wherein a thin gap (90) is formed between the peripheral surface and the inner wall, the gap providing a further passage fro fluid (fig. 4, 8)." (Office Action at 17.) Richmond does not, however, cure the above-mentioned deficiencies of Kahana. Accordingly, the cited references do not disclose each and every limitation of amended independent claim 44. Therefore, claim 44 is allowable over the cited references. Thus, claim 58 is allowable at least due to its dependence from allowable independent claim 44.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 11, 2008

By /Aaron L. Parker/
Aaron L. Parker
Reg. No. 50,785
(202) 408-4000

Attachment: **a Terminal Disclaimer.**